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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,664	01/23/2002	Rudolf Zink	HP/5-21844/A/PCT/DIV	9293

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PATENT DEPARTMENT
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EXAMINER

VOLLANO, JEAN F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,664

Applicant(s)

ZINK ET AL

Examiner

Jean F. Vollano

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 12 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 12 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 09/806,349.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.

4) ☐ Interview Summary (PTO-413) Paper No(s). ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____.

DETAILED ACTION

1. The amendment filed 12/08/2003 has been entered. Claim 13 has been canceled and claim 12 is pending.

2. The examiner that was examining this application has transferred it to Art Unit 1621 to a new examiner. The new examiner was told, upon receipt of this application, that the non elected subject matter was not removed from the claim . The new examiner has reviewed the record and it is unclear whether the election of the species of the previous examiner was limiting the claim to the elected species group, since after the species was found and cited, the examination appeared to be terminated, or if the examiner was acting on a broader elected group. The record is confusing as to what exactly was being done. Since the previous examiner stopped upon the one elected species being found, and since the present examiner was told that the non elected subject matter was not removed the application will be treated as an election of species for the compound claim. It is noted that in the previous examiner's office action (9/4/2003) all but the elected species was withdrawn from consideration as being drawn to a non elected group . Applicant has only removed the elected species and as such the examiner continues until a new species is found. If no species is found the whole claim is searched in its entirety. If the species is found the examiner then stops the search and gives that rejection.

3. However as a courtesy to Applicant and because of the change in examiner even if the examiner finds a species the examiner will continue search the whole claim in its entirety and give every rejection found to help hasten prosecution.
4. The amendment has overcome the 35 USC 102(b) as anticipated by Kuhltau and the rejection is withdrawn.
5. The examiner notes that there has been no PTO 1449 sent in with references. This is not required and the examiner is only stating this for clarity of the record. Applicant has sent in an IDS which references US 6358496 but that is the parent application of this instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Bayer A.G. (GB929394).

Bayer et al teaches compounds of formula (12) wherein R2 are methyls, R1 is a chloro, or a methyl or a methoxy or a hydrogen and R3 is a methyl R4 is a H.

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When Bayer et al teaches a compound of formula (12) wherein R5 is a moiety of formula (1d) and R9 is ethyl then the claim is fully anticipated (see the tables and attached abstract).

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated Chem abs 470 (121:191470).

Chem abs 470 teaches compounds of formula (12) wherein R2 are methyls, R1 is a hydrogen and R3 is a methyl R4 is a H.

When Bayer et al teaches a compound of formula (12) wherein R5 is a moiety of formula (1d) and R9 is methyl then the claim is fully anticipated .

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 214 (CA: 79:20214).

Chem abs 214 teaches compounds of formula (12) wherein R2 are methyls, R1 is a t-butyl group , R3 is a methyl R4 is a H.

When Chem abs 214 teaches a compound of formula (12) wherein R5 is a 1b which is an aldehyde then the claim is fully anticipated.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 279 (CA: 85:48279).

Chem abs 279 teaches compounds of formula (12) wherein R2 are methyls, R1 is a methoxy, hydrogen, methyl or chloro group , R3 is a methyl R4 is a H.

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When Chem abs 214 teaches a compound of formula (12) wherein R5 is a 1b which is an aldehyde then the claim is fully anticipated.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 279 (CA: 87:24782).

Chem abs 782 teaches compounds of formula (12) wherein R2 are methyls, R1 is a methoxy, hydrogen, methyl or chloro group, R3 is a methyl or when R1 is hydrogen R3 is an ethyl, and R4 is a H.

When Chem abs 214 teaches a compound of formula (12) wherein R5 is a 1b which is an aldehyde then the claim is fully anticipated.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 096 (CA: 110:156096).

Chem abs 096 teaches compounds of formula (12) wherein R2 are isobutyls, R1 is a hydrogen, R3 is a methyl, and R4 is a H.

When Chem abs 214 teaches a compound of formula (12) wherein R5 is a 1b which is an aldehyde then the claim is fully anticipated.

6. The examiner notes that the claim was examined in full and all the relevant art has been applied. The examiner did not find any compounds with the dihalotriazine as R3 for the given structure. Nor were there any compounds found for the given structure wherein R4 was -HC=O .

Claim Rejections - 35 USC § 112

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 has a newly added limitation of “compound of formula (1)” . There is no compound of formula 1. There is a compound of formula (12) and there are moieties of formula 1(a), 1(d) and 1(b). Therefore the claim is confusing as to what are the metes and bounds of the limitation.

The examiner also notes that there is a compound of the formula (1b) followed by an – HC=O (aldehyde) this would be clearer if it read “a compound of the formula (1b) which is – HC=O”. The same reasoning applies to formula (1a) and formula (1d). This is not a rejection but a suggestion to be clearer.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

CA:91:40910 , CA:109:39299 and CA:107:238576 are cumulative to the 102(b) rejections given above.

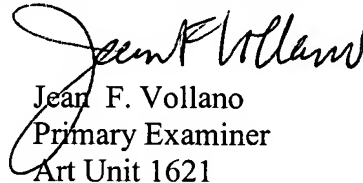
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 571-2720648. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272- 0646. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Jean F. Vollano
Primary Examiner
Art Unit 1621

February 11, 2004